



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,894	05/25/2001	J. Brian Searles	20325-000100	8031

20350 7590 03/25/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,894

Applicant(s)

SEARLES, J. BRIAN

Examiner

Tamara L. Graysay

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1 page</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to
 - a. as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 624 (bottom of Fig. 6A); and,
 - b. as failing to comply with 37 CFR 1.83(a) because they must show every feature of the invention specified in the claims. Therefore, the alternative embodiment including accepting an electronic identification, determining whether the list includes the notation, automatically modifying the list, and collecting information (i.e., manually updating), as recited in claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities:

Art Unit: 3623

- a. The term Internet should be capitalized when referring to an electronic communications network that connects computer networks and organizational computer facilities around the world.
- b. P.7, L.13, “short” should be long.
- c. P.8, L.21, “filed” should be field.

Appropriate correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification reads, at page 6, lines 29-30, “In an alternative embodiment, this automatic-update feature is not included. Instead, the notification of unavailability is only removed by actively signing into the system.”

Thus, the specification does not provide proper antecedent basis for the embodiment recited in claim 6 (and in claim 7), which claims both the automatic-update feature when time (or date) passes AND actively signing into the system.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter.

The claims have been evaluated as a computer-related invention due to the disclosed computer hardware or combination of hardware and software.

A computer-related process claim is first evaluated to determine if it falls within the specific safe harbor categories of statutory post-computer or pre-computer activity. In the present application, the process claims do not include post-computer activity (i.e., there is no step during which an independent physical act is performed outside a computer) or pre-computer activity (i.e., there is no step during which manipulation of data representing physical objects or activities occurs).

Without such activity, a process claim is then evaluated to determine whether it is limited to a practical application within the technological arts.

A process claim that has a practical application is one that provides a useful, concrete, and tangible result. In the present application, the claims include maintaining a list, and modifying the list under certain conditions. The modified list has a practical application of providing updated information related to the unavailability of the unit.

A process claim that is within the technological arts is one that applies, involves, uses, or advances technology. In the present application, the claims are drawn to a process including *inter alia* accepting an “electronic” identification of a unit and “automatically” modifying the list. The definition of automatically (reflex; done or produced as if by machine) is not restricted only to a machine or computer function. For example: automatically blinking the eyelids, and the persons answers were automatically provided. The recitation of “automatically” in the claims does not in and of itself render statutory that which is otherwise nonstatutory. The claims further include accepting an “electronic” identification. This feature includes a medium by

Art Unit: 3623

which information is transmitted. However, the step recited is accepting information, and thus the use of a medium by which information is transmitted is merely a nominal recitation of technology. The identification is not electronically accepted, but rather the process requires accepting an electronic identification. For example, the person performing the process may receive the identification by answering a telephone call or by viewing a television monitor. Thus, the step of accepting does not require more than nominal use of technology.

Therefore, claims 1-12 are directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The fourth subparagraph of claims 1 and 13, and the sixth subparagraph of claim 16 are confusing in that the claimed feature will remove the unavailable notation if the unit is unavailable. If the unavailable notation for the unit were removed, then it would seem that the unit were available, i.e., accepting an electronic identification of the unit, rather than unavailable. The claims have been treated as modifying the list to remove the notation that the particular unit is unavailable if it is determined that the list includes a notation that the particular unit is unavailable.

b. The fifth subparagraph of claims 1 and 13, and the seventh subparagraph of claim 16 are confusing in that the claimed feature will specify unavailability of the unit if the unit is not unavailable. If the collecting step were performed when the particular unit is not unavailable, then it would seem that the unit were providing information as to the unit's unavailability. The claims have been treated as collecting information specifying unavailability of the particular unit if it is determined that the list includes a notation that the particular unit is not unavailable.

c. Claims 6 and 7 (dependent upon claim 1) further comprise automatically removing the notation when the time passes or on that date; however, claim 1 recites automatically modifying the list to remove the notation. The steps are confusing because it is not clear whether the steps recited in claims 6 and 7 are intended to further modify the automatically modifying step as set forth in claim 1, or whether the steps in claims 6 and 7 are in addition to the step(s) recited in claim 1. If the step recited in claim 6 is in addition to the steps recited in claim 1, then the claim is not clear as to when the step occurs relative to the series of steps recited in claim 1. Similarly, if the step recited in claim 7 is in addition to the steps recited in claim 1, then the claim is not clear as to when the step occurs relative to the series of steps recited in claim 1. The step recited in claim 6 (and the step recited in claim 7) has been treated as occurring after the maintaining step.

d. Claims 8 and 9 are confusing in that they include all the limitations of independent claim 1, which recites determining whether "the list" includes "the notation" and automatically modifying "the list." If the step of maintaining the list, as recited in claim 1, is modified by dependent claims 8 and 9 to include a second list, then the determining

Art Unit: 3623

and modifying steps are rendered indefinite as to whether the determining and modifying steps are manipulating the first list or the second list. This claim has been interpreted as maintaining more than one list that identifies the units.

e. Claim 9, “the list” lacks clear antecedent basis because both “a list” and “a second list” are recited in antecedent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Rassman (cited by applicant, US-4937743).

a. Regarding claim 1, Rassman discloses maintaining a list identifying the plurality of units (operating rooms for example) including a notation indicating whether each unit is unavailable (see Fig. 1 for example); accepting an electronic identification of a particular unit (entry by the operator and designated Rm1, Rm2, etc.); determining whether the list includes the notation that a unit is unavailable (conflict indicia for example at C.5, L.8-17; C.6, L.6-18; C.6, L.51-59, etc.); automatically modifying the list to remove the notation that the unit is unavailable if it is determined that the unit is available (updated from real time sources C.4, L.24-31); collecting information specifying unavailability of

the unit if it is determined that the unit is not unavailable (the operator loads information and proceeds to schedule the resources C.6, L.19-59).

b. Regarding claims 2 and 3, Rassman includes a display of the information including headings (see figures) in a language. The limitation of “selected by a user” is of no import as to the method steps recited. The language of the program is inherently the language selected by the user.

c. Regarding claim 4, Rassman discloses displaying a listing of only units that are unavailable (scheduling indicia for historical and prospective utilization of units and status indicia to monitor and display progress of a procedure C.3, L.2-11, C.6, L.6-18; selectively changing the display in order to present data relating to different aspects of one or more resources C.3, L.15-18).

d. Regarding claim 5, Rassman discloses modifying the list to include the collected information.

e. Regarding claims 6 and 7, Rassman discloses automatically removing a notation when the time passes or when on that date insofar as the Rassman list is updated from a real time source (C.4, L.23-31) and each time the system is updated the current information would reflect the modified list of units that are unavailable (i.e., resources in use).

f. Regarding claims 8 and 9, only the maintaining step has been modified. In light of the indefiniteness noted above, Rassman discloses maintaining a database having more than one “notation,” as broadly recited, in that the Rassman method includes selectively

Art Unit: 3623

changing the display in order to present data relating to different aspects of one or more resources C.3, L.15-18.

g. Regarding claims 10 and 11, Rassman discloses the units (resources) may be persons, employees of a business organization (surgeons at a hospital C.5, L.51 to C.6, L.5).

h. Regarding claim 12, Rassman discloses the units (resources) may be a station (room, piece of equipment, or the like C.5, L.51-58).

i. Regarding claims 13-15, Rassman discloses a computer computer-readable medium (database memory) and programs to enable the monitoring to be performed.

j. Regarding claim 16, Rassman discloses a storage device (database) and processor (inputting, modifying, handling, accessing, and displaying the data can be carried out using known methods and techniques C.4, L.32-35).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rassman (cited by applicant, US-4937743).

Rassman is silent as to the number of input devices and display devices to which the processor is connected, and the type of connection between the devices.

Art Unit: 3623

The examiner takes Official Notice that at the time of the invention using a plurality of input devices and display devices connected over a network or the Internet was old and well established in business as a convenient way for multiple users to enter and access information contained in a computer system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rassman to include the a processor that is connected to multiple input devices and multiple display devices via a network or the Internet because the skilled artisan would have recognized that this business practice streamlines the data entry process and saves time spent by a user accessing the information contained in the computer. These advantages are well known to those skilled in the business art.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Tanaka (JP-10117243-A) teaches automatically updating information in a database from another location on a periodic basis.
- Hirsch (WO-9725682-A1) teaches a scheduling system for operating rooms and/or surgeons.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

Art Unit: 3623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamara L. Graysay
Examiner
Art Unit 3623

03172005